

REMARKS

Claims 1-52 are pending in the present Application, and all claims currently stand rejected under 35 U.S.C. 103(a). Accordingly, claims 1, 21, 41-47, 49, and 52 are amended, and new claims 53-62 are added herein.

Reconsideration of the Application in view of the foregoing amendment and the following remarks is respectfully requested.

35 U.S.C. § 103

On page 2 of the Office Action, the Examiner rejects claims 1-4, 6-24, and 26-52 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. US2004/0201709 to McIntyre et al. (hereafter McIntyre) in view of Japan Patent No. JP 2003-141031 to Hiroshi (hereafter Hiroshi). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness because the cited references fail to teach “all the claim limitations.”

Regarding the Examiner’s rejection of independent claims 1, 21, 41-43, 45, 47, and 52, Applicants respond to the Examiner’s §103 rejections as if applied to similarly-amended independent claims 1, 21, 41-43, 45, 47, and 52. For example, independent claim 1 is now amended to recite “*said source mail program automatically creating a photo message that includes said photo data and photo identifier means to request a special handling of said photo data, said photo identifier means associating said photo data with a target photo album*” (emphasis added), and “*said target photo manager automatically associating said photo data with said target photo album of said target device, said target photo album being viewed on said target device*” (emphasis added), which are limitations that are not taught or suggested either by the cited references, or by the Examiner’s citations thereto.

McIntyre essentially teaches an “electronic camera 23” that downloads captured images through a “service provider 80” to the camera user’s “computer 10” (see FIG. 15). However, in independent claims 1 and 21, Applicants expressly claim a “target device” that is uniquely configured for “automatically detecting” the receipt of a “photo message” from a “source device,” and “automatically associating said photo data with a target photo album” (emphasis added) without direct intervention by a target device user. Applicants submit that McIntyre nowhere

teaches or suggests any techniques for “automatically” detecting and populating an electronic photo album on a target device.

Furthermore, Applicants submit that McIntyre fails to teach a source device for “automatically creating a photo message that includes said photo data and photo identifier means to request a special handling of said photo data” so that the target device can automatically detect the “photo identifier means” and “automatically” populate the “target photo album” (emphasis added). In particular, Applicants submit that McIntyre fails to disclose the “photo identifier means” that is disclosed and claimed by Applicants.

On page 3 of the Office Action, with regard to claims 1, 21, 41-47, and 52, the Examiner concedes that McIntyre “*fails to disclose a photo identifier means to request a special handling of said photo data.*” Applicants concur. The Examiner then points to Hiroshi to remedy the foregoing defects. Hiroshi teaches using a “code” that is used only to determine “storage locations” for images received by email. The images are later displayed by a separate “web server device” on a remote Internet website for viewing (see paragraphs 0013-0015).

Applicants submit that their “photo identifier means” is not analogous to the “code” of Hiroshi because their respective purposes are significantly different. The “code” of Hiroshi is used only to designate “storage locations,” while the Applicants’ “photo identifier means” is created for automatically “*associating said photo data with a target photo album,*” as now recited in the amended independent claims. Applicants disclose and claim “photo identifier means” that identify the fact that a given “photo message” is intended for automatic association with a “target photo

album.” Applicants’ claimed “photo identifier means” does not merely specify a “storage location,” as described in Hiroshi. Applicants therefore submit that the purpose and functionality of their “photo identifier means” are significantly different from that of the “code” that is disclosed by Hiroshi.

On page 3 of the Office Action, the Examiner also concedes that McIntyre fails to disclose “*said target photo manager automatically storing said photo data into a target photo album,*” and again points to Hiroshi for support. Applicants respectfully traverse. Hiroshi teaches utilizing downloaded images for subsequently displaying on a remote Internet website by a separate web server that was not the original target device (see paragraph 0031). In contrast, Applicants submit that their “photo data” is intended for a “target photo album” that is viewed directly “*on said target device,*” as now recited in the amended independent claims.

In addition, the Examiner repeatedly cites paragraph 0100 of McIntyre against various limitations claimed by Applicants. Paragraph 0100 of McIntyre discusses the utilization of a single “camera 23” from the embodiment of FIG. 15 for both capturing image data, and for also transmitting the captured image data to a target destination. The “camera 23” of McIntyre is therefore implemented to perform two different functions within the same physical device. In contrast, in independent claims 1 and 21, Applicants affirmatively recite a discrete “photo data source” and a separate “source device” as distinct and individual entities. Applicant therefore respectfully submit that the single unitary “camera 23” shown in FIG. 15 of McIntyre cannot accurately be analogized to the two different

claimed elements (“photo data source” and “source device”) that are specifically recited by Applicants as separate entities.

With regard to claim 42, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 as discussed above. Applicants therefore incorporate those remarks by reference with regard to claim 42. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 42, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of the cited references and Applicants’ invention as disclosed in the Specification, claim 42 is therefore not anticipated or made obvious by the teachings of the cited references.

With further regard to independent claim 52, Applicants submit that neither of the cited references teach certain of the limitations presented in claim 52. For example, Applicants submit that the cited references fails to teach “*said portable electronic device automatically creating a special identifier tag to designate said photo data for said streamlined photo distribution procedure,*” in conjunction with a separate “source device” that automatically creates “*a photo identifier tag to request a special handling of said photo data, said photo identifier tag associating said photo data with a target photo album*” (emphasis added). Applicants submit

that the cited references fail to teach two different identifier tags that are created by two different devices in the transmission path.

Furthermore, Applicants submit that the cited references fail to teach “*said source photo manager designating a message target group for receiving said photo data from said source device*” (emphasis added). In particular, Applicants submit that the cited references nowhere teach designating multiple target devices from a “message target group,” as recited by Applicants in claim 52.

Regarding the Examiner’s rejection of dependent claims 2-4, 6-20, 22-24, 26-40, 44, 46, and 48-51, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-4, 6-20, 22-24, 26-40, 44, 46, and 48-51, so that these claims may issue in a timely manner.

With regard to the rejections of claims 16, 18, 36, and 38, the Examiner cursorily concludes that certain claimed limitations would have been “obvious” without providing any specific additional references to support these rejections of claimed limitations that the Examiner acknowledges are not shown in the cited references.

It appears that the Examiner is tacitly utilizing Official Notice without expressly stating so. Applicants submit that the particular combination of

claimed limitations would not be obvious to one skilled in the art at the time of the invention. Applicants further submit that the Examiner has improperly utilized Official Notice because the cited limitations are uniquely utilized by the Applicants to produce novel combinations that are not well-known or predictable. Applicants therefore respectfully request the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 16, 18, 36, and 38, so that these claims may issue in a timely manner.

For all of the foregoing reasons, the Applicants submit that claims 1-4, 6-24, and 26-52 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 1-4, 6-24, and 26-52 under 35 U.S.C. § 103.

On page 6 of the Office Action, the Examiner rejects claims 5 and 25 under 35 U.S.C. § 103 as being unpatentable over McIntyre and Hiroshi in view of an Internet publication entitled "PC Game History" (hereafter Game History). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie*

case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 5 and 25, for at least the reasons that these claims are dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims 5 and 25, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested.

For at least the foregoing reasons, the Applicants submit that claims 5 and 25 are not unpatentable under 35 U.S.C. § 103 over the cited references, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 5 and 25 under 35 U.S.C. § 103.

New Claims

The Applicants herein submit additional claims 53-62 for consideration by the Examiner in the present Application. The new claims 53-62 as well as any claim amendments are put forth by the Applicants for reasons of clarity. The new claims 53-62 recite specific detailed embodiments for implementation and utilization of Applicants' invention, as disclosed and discussed in the Specification. Applicants submit that newly-added claims 53-62 contain a number of limitations that are not taught or suggested in any of the cited references.

In particular, Applicants submit that cited references fail to teach that "said photo distribution procedure is implemented by utilizing a one-click technique in which a system user performs only one single triggering action to initiate said photo distribution procedure, said source device responsively capturing said photo data, creating said photo message, and sending said photo message to said target photo album in an automatic manner," as recited in dependent claim 53.

Applicants also submit that cited references fail to teach that "said photo distribution procedure automatically synchronizes said source photo album and said target photo album to contain identical digital photographs," as recited in dependent claim 54, and that "said photo identifier means is created concurrently with sending said photo message to said target device, said photo identifier means not being created beforehand," as recited in dependent claim 55.

Applicants further submit that cited references fail to teach that "said source device and said target device are implemented by utilizing a substantially

similar device configuration,” as recited in dependent claim 56, and that “said source device and said target device are both implemented as electronic gaming devices in an electronic gaming network,” as recited in dependent claim 57. In addition, Applicants submit that cited references fail to teach that “said source device and said photo data source are two separate non-integral electronic devices,” as recited in dependent claim 58, and that “said source device transmits said photo message directly to said target device through a peer-to-peer connection that does not include any intermediate server device,” as recited in dependent claim 59.

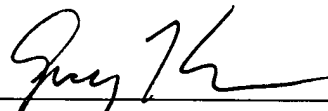
Finally, Applicants submit that cited references fail to teach that “said photo data source transmits said photo data directly to said source device through a direct electrical connection that does not include any intermediate server device,” as recited in dependent claim 60, that “said photo message transmits auxiliary data that includes text data and audio data,” as recited in dependent claim 61, and that “said photo data is transmitted in a full-resolution format as originally captured by said photo data source,” as recited in dependent claim 62. For all the foregoing reasons, Applicants therefore respectfully request the Examiner to consider and allow new claims 53-62.

Summary

Applicants submit that the foregoing amendment and remarks overcome the Examiner's rejections under 35 U.S.C. §103(a). Because the cited references, and the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-62, so that the present Application may issue in a timely manner. If there are any questions concerning this Response, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

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